

REMARKS

In the Office Action, the Examiner:

rejected claims 31-40 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

rejected claims 21-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement;

rejected claims 21, 22, 24, 31, 32, and 34 under 35 U.S.C. § 102(a) and § 102(e) as being anticipated by U.S. Patent No. 6,409,514 to Bull (henceforth, "*Bull*");

rejected claims 23, 25-29, 33, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over *Bull* in view of Official Notice.

rejected claims 30 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Bull* in view of PCT Publication No. WO 98/03953 to Simmons (henceforth, "*Simmons*") and U.S. Patent No. 6,157,808 to Hollingsworth (henceforth, "*Hollingsworth*").

Claims 31-40 remain pending.

Applicants acknowledge, with appreciation, the courtesies extended in a telephonic interview conducted on July 7, 2009, between the undersigned and Examiner Caredenas-Navia. Also present on the call was Luke McCammon of Finnegan. In accordance with 37 C.F.R. § 1.133(b), the interview focused on the 35 U.S.C. § 101 rejection of claims 31-40, to confirm that amending claims 31-40 to be directed to "using a computer module" or "executing on a computer" would suffice to overcome these rejections. Also addressed during the interview were the rejections under 35 U.S.C. § 112 of claims 31-41, specifically identifying portions of the specification containing a written description which would enable one skilled in the art to practice the claims. The Examiner suggested amendments which may be sufficient to overcome the 35 U.S.C.

§ 101 amendments and considered Applicants reasoning regarding the 35 U.S.C. § 112 rejections.

Rejection of Claims 31-40 under 35 U.S.C. § 101:

Applicant has herein amended the claims to even further clarify “which steps are executed on the computer” (Office Action at p. 6). Thus, Applicant respectfully requests withdrawal of these rejections.

Rejection of Claims 31-40 under 35 U.S.C. § 112:

Applicant traverses the rejection of claims 31-40 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. 35 U.S.C. § 112 states that the specification “shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, . . . to make and use the same” (emphasis added). Although many of the claims have been amended, rendering moot many of these rejections, Applicant asserts that the disclosure in the specification fully enables one skilled in the art to practice the claims.

The Office argues that “capturing and storing user data” for the intended use of forecasting demand is not enabled, in part because the specification does not disclose exactly what user data is collected or exactly how it is collected. These minute details are not spelled out in the specification because, given the situation, one of skill in the art would understand that there may be any number of different types of user data which would be appropriate to collect or any number of ways to collect that data. As a result, the specification does not limit itself in the application of this claim element. That said, a person skilled in the art would not need further disclosure to understand how to capture

user data, how to collect the user data, or how to forecast demand based on that data. One of skill in the art would have the necessary skill to perform this and other claimed applications without unnecessary additional disclosure. The disclosure is similarly sufficient for all other claim elements which have improperly been rejected under 35 U.S.C. § 112.

Rejection of Claims 31, 32, and 34 under 35 U.S.C. § 102:

Applicants respectfully traverse the rejections of claims 31, 32, and 34 under 35 U.S.C. § 102 as being anticipated by *Bull*. In order to properly establish that *Bull* anticipates Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference.

Independent claim 31, as amended, distinguishes itself from the prior art at least by reciting "forecasting future demand for the course based on the delivery criteria." The recitations within *Bull* cited by the Office as disclosing forecasting demand, however, refer only to current demand of courses. For instance, the Office cites to "scheduling the available class" or, if a class needs a larger enrollment than can be handled then the course can be "broken into course sections." (*Bull* at Col. 3 lines 54-60). This disclosure relating to scheduling and enrollment sizes relates to existing demand. *Bull* has no disclosure or teaching of forecasting the future demand of a course. For at least this reason, *Bull* fails to teach each and every element of claim 31 and cannot anticipate claim 31. Accordingly claim 31 is allowable over *Bull*. Claims 32, and 34 are allowable over *Bull* at least due to their dependence from claim 31.

Amended independent claim 31 also distinguishes itself from the prior art at least be reciting “indexing and storing the course when it is no longer utilized.” Although the Office argued that *Bull* disclosed “inputting courses” and that this constituted the claimed “archiving course content,” which Applicant does not concede, the amended claim even further clarifies the steps taken when the course “is no longer utilized.” *Bull* discloses only the management of currently utilized courses, and therefore has no disclosure of “indexing and storing the course when it is no longer utilized.”

Amended independent claim 31 also distinguishes itself from the prior art at least be reciting “delivering a field test of the course to evaluate course content.” Although the Office argued that *Bull* disclosed “delivering courses,” the amended claim further recites “delivering a field test of the course to evaluate course content.” *Bull* discloses only the delivery of a course, with no indication that “a field test” is delivered or that one is done to “evaluate course content”, and therefore has no disclosure of “delivering a field test of the course to evaluate course content.”

For at least these reasons, *Bull* fails to teach each and every element of claim 31 and cannot anticipate claim 31. Accordingly claim 31 is allowable over *Bull*. Claims 32, and 34 are allowable over *Bull* at least due to their dependence from claim 31.

Rejection of Claims 33, 35-39 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the Office’s rejections of claims 33, 35-39 under 35 U.S.C. § 103(a). The Office has liberally taken Official Notice in an effort to support all of these rejections. “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration

as being well-known." M.P.E.P. § 2144.03(A). "It [is] not. . . appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." *Id.*

The Office has failed to comply with these requirements. For instance, the Office states that "outsourcing training to an independent entity that is acting according to a service level agreement" of claim 39 is "old and well-known," yet none of the references make any mention of outsourcing training or a service level agreement. Thus, it cannot be said that this claim element is capable of "instant and unquestionable demonstration as being well-known," as is required in order to make use of Official Notice. Should the Office maintain the rejection after considering the reasoning presented herein, Applicant respectfully requests the Examiner to provide "the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately [allow Applicant to] traverse the rejection in the next reply after the Office action in which the common knowledge statement was made." M.P.E.P. § 2144.03(B).

Rejection of Claim 40 under 35 U.S.C. § 103(a):

Applicant respectfully traverses the Office's rejection of claim 40 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35

U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

As amended, claim 40 states that “the delivery criteria used to forecast future demand is selected from the group consisting of” The Office cites portions of *Bull*, *Hollingsworth*, and *Simmons* that indicate that data from that group exists, yet these references give no indication that this data is in any way used to forecast future demand, as required by claim 40. The amended claims even further specify that this data is “used to forecast future demand.” Thus, the mere existence of the type of data in the references’ disclosure is insufficient to support a rejection of claim 40 under 35 U.S.C. § 103(a) as being unpatentable over *Bull* in view of *Simmons* and *Hollingsworth*. Thus these rejections are improper and should be withdrawn.

All claims are thus allowable for the failure of the art to disclose, teach, suggest, or otherwise render obvious the recited combination of elements. Applicant requests favorable reconsideration of the claims including issuance of a timely Notice of Allowance.

Application No. 10/608,428
Attorney Docket No. 10761.1358

CONCLUSION

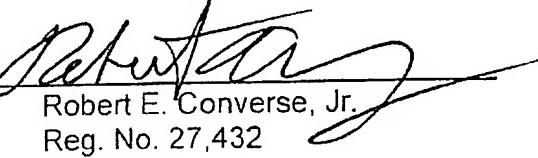
If there are any fees due in connection with the filing of this Response and Amendment which are not covered by the concurrently submitted transmittal document, please charge any necessary fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 17, 2009

By:


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